



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,545	08/09/2001	Peter Schlemm	A-2812	6082

24131 7590 01/14/2008
LERNER GREENBERG STEMER LLP
P O BOX 2480
HOLLYWOOD, FL 33022-2480

EXAMINER

GUTIERREZ, ANTHONY

ART UNIT	PAPER NUMBER
2857	

MAIL DATE	DELIVERY MODE
01/14/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/927,545

Applicant(s)

SCHLEMM, PETER

Examiner

Anthony Gutierrez

Art Unit

2857

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/17/07 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-5, 7-9, and 11-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Someno et al. (Patent No: US 7,050,194 B1).

As to claim 1, Someno et al. discloses a method of executing method steps with an apparatus controlling a printing press (see Abstract), the method which comprises (see Fig.1): connecting the apparatus (90) to an input unit (14); enabling the apparatus for switching an error mode on or off via the input unit and checking whether the error

Art Unit: 2857

mode is switched on via the input unit (coil. 8, lines 40-46 which discloses that there are two modes, the continuous printing mode and the standard printing mode, col. 11, lines 64-66, which teaches that the standard error mode is equivalent to an error mode, and col. 4, lines 32-44 which teaches that the input allows for specification of the continuous mode (thus switching the standard (error) mode off when the continuous mode is specified and switching the standard (error) mode on when the continuous mode is not specified)); and producing an output signal in a method step and outputting the output signal as at least one of an optical or an acoustic signal (col. 6, lines 23-24 and 29-31) if the error mode is switched on and not outputting the output signal if the error mode is not switched on (col. 11, line 64-col. 12, line 3 and col. 14, lines 33-46).

As to claim 2, Someno et al. discloses the method according to claim 1 as addressed above and further that the method steps are divided into modules, and the method comprises changing from one module to another module during the execution of the method steps, and wherein the output signal comprises an identifier indicating in which module the output signal was produced (col. 8, lines 17-31).

As to claim 3, Someno et al. discloses the method according to claim 1 as addressed above including executing the method steps in a plurality of devices, and generating the output signal with an identifier indicating the device in which the output signal was produced (col. 10, lines 11-26).

As to claim 4, Someno et al. discloses the method according to claim 1 as addressed above, and further that the method steps are stored as digital data in a storage device, and the method comprises reading out the method steps from the storage device and executed the method steps, and wherein the output signal

Art Unit: 2857

comprises an identifier indicating where the method step is stored that produced the output signal (col. 11, lines 4-16).

As to claim 5, Someno et al. discloses the method according to claim 1 as addressed above and further that the output signal comprises an identifier indicating in which method step the output signal was produced (col. 12, lines 10-24).

As to claim 7, Someno et al. discloses the method according to claim 1, including outputting the output signal via an output unit (Fig.1, element 85).

As to claim 8, Someno et al. discloses the method according to claim 1, and further that the output signal is stored in a storage device, together with an indication of a time at which the output signal was stored (col. 8, line 60-col.9, line 3).

As to claim 9, Someno et al. discloses a device for executing method steps, which comprises a control apparatus for controlling a printing press (see Abstract), said control apparatus (Fig. 1, element 90) producing an output signal (Fig. 1, element 85), said control apparatus being connected to an input unit (Fig. 1, element 14) and configured for enabling an error mode to be switched on or off via said input unit, to check whether an error mode is switched on via said input unit (col. 8, lines 40-46 which discloses that there are two modes, the continuous printing mode and the standard printing mode, col. 11, lines 64-66, which teaches that the standard error mode is equivalent to an error mode, and col. 4, lines 32-44 which teaches that the input allows for specification of the continuous mode (thus switching the standard (error) mode off when the continuous mode is specified and switching the standard (error) mode on when the continuous mode is not specified)), and to output the output signal as at least one of an optical or an acoustic signal if the error mode is switched on (col. 6, lines 23-

Art Unit: 2857

24 and 29-31) via said input unit and not to output the output signal if the error mode is not switched on via said input unit (col. 11, line 64-col. 12, line 3 and col. 14, lines 33-46).

As to claim 11, Someno et al. discloses The device according to claim 9, and further that the output signal includes an identifier indicating at which method step the output signal was produced (col. 12, lines 10-24).

As to claim 12, Someno et al. discloses the device according to claim 10, and further that at least one of said first and second control apparatus executes method steps in the form of program modules, and the output signal comprises an identifier indicating the module in which the output signal was produced (col. 8, lines 17-31).

As to claim 13, Someno et al. discloses the device according to claim 10, including a storage device storing the method steps; and wherein at least one of said first and second control apparatus is configured to read out the method steps for the execution from the storage device; and wherein the output signal comprises an identifier indicating a location at which the method steps are stored as digital data in said storage device (col. 11, lines 4-16).

As to claim 14, Someno et al. discloses the device according to claim 13, and further that the location is identified in said storage device via a memory address (col. 11, lines 1-3).

As to claim 15, Someno et al. discloses the device according to claim 13, and further that the location is identified in said storage device via a data filename (col. 8, lines 3-5).

Art Unit: 2857

As to claim 16, Someno et al. discloses the device according to claim 9, further including input means configured to enable selective switching on and switching off of the error mode even during the execution of the method steps. (Fig.1 element 84).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6 and 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Someno et al. (Patent No: US 7,050,194 B1).

As to claim 6, Someno et al. discloses the claimed invention except for the error mode being one of a plurality of error modes. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention consistent with a plurality of error modes since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (1977).

As to claim 10, Someno et al. discloses the claimed invention except for a second control apparatus. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the invention with additional apparatuses since it has been held that mere duplication of the essential working parts

Art Unit: 2857

of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8 (1977).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Gutierrez whose telephone number is (571) 272-2215. The examiner can normally be reached on Monday to Thursday, 8:30 AM-7:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eliseo Ramos-Feliciano can be reached on (571) 272-7925. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AG
Anthony Gutierrez
Art Unit 2857
1/3/08

ERF 117107
ELISEO RAMOS-FELICIANO
SUPERVISORY PATENT EXAMINER